

### REMARKS

In the application claims 1-16 remain pending. No claims have been canceled and no new claims have been added.

All of pending claims presently stand rejected. The reconsideration of the rejection of the claims is, however, respectfully requested.

At this time, the applicants would like to thank the examiner for the courtesies extended during a recent phone conversation wherein the rejection of claims 1-3, 6, 7, and 9-13 under 35 U.S.C. § 101 was discussed. During that phone conversation it was agreed that the claims as presented include the structural/functional interrelationships required by 35 U.S.C. § 101. Accordingly, it was agreed that the rejection under 35 U.S.C. § 101 would be withdrawn.

In the Office Action, claim 6 was rejected under 35 U.S.C. § 112 for the reason that claim 6 included an element without a proper antecedent. In response, claim 6 has been amended to cure the noted informality. Claim 9 has also been amended to cure the same informality. Believing that the claims as amended now comply with the requirements of 35 U.S.C. § 112, it is respectfully requested that this rejection be withdrawn.

Pending claims 1 and 6-16 presently stand rejected under 35 U.S.C. § 103 as being rendered obvious by Talib (U.S. Patent No. 2001/004758) as modified by Liddy (U.S. Patent No. 6,304,864). In rejecting the claims, the Office Action set forth that Talib discloses "the invention substantially as claimed" including receiving an electronic request for information for the product (citing to Para. 19, lines 4 – 5); searching a database to determine if the database contains information for the product (citing to Para. 19, lines 5 – 10); if the database contains information for the product, sending an

electronic message to the customer containing selected information for the database corresponding to the product (citing to Para. 19, lines 10 – 15); if information is not found for the product, performing a subsequent search to gather information for the product (citing to Figs. 10 and 11; Para. 120 – 146), sending the gathered information in an electronic message to the customer (citing to Para. 19), and adding gathered information to the database (citing to Para. 6). While the Office Action acknowledged that Talib fails to disclose, teach, or suggest, among other things, a sourcing agent performing an off-line search, the Office Action nevertheless asserted that such was disclosed in Liddy (citing to Col. 9, line 49-Col. 11, line 57). Thus, the Office Action concluded that it would have been obvious to broaden the product search disclosed by Talib by searching additional databases as disclosed by Libby because “this would have given a greater search area and increased the likelihood that the customer would receive relevant information from subsequent searches.”

In response to the rejection of the claims, it is respectfully submitted that a prima facie case of obviousness under 35 U.S.C. § 103 requires that the combination of prior art references disclose each and every element set forth in the claims, considering each and every word. This requirement that the claimed invention be considered “as a whole” is meant to prevent evaluation of an invention part by part, i.e., breaking an invention into its component parts and then merely finding a reference containing one part, another reference containing another part, etc., and to prevent the impermissible use of the specification of the applicant as a template to combine these parts for the purpose of deprecating the claimed invention. Thus, to assure that such “hindsight reasoning” is not used when assessing the patentability of a claimed invention, a rejection under 35 U.S.C.

§ 103 requires a demonstration that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have selected the various parts from the references and combined them in the claimed manner. Furthermore, if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

With these requirements for maintaining a rejection under 35 U.S.C. § 103 in mind, it is first respectfully submitted that Talib fails to “disclose the invention substantially as claimed.” Specifically, Talib is directed to a system for searching an electronic catalog that solves, among others, the problem of user frustration associated with a user searching for a product that does not exist within the product database (See Para. 29, lines 1-4). To solve this problem, Talib only allows a user to search for products that are already within the product database and which have been tagged with various taxonomy labels. In this manner, when a user enters a search query, the system of Talib presents to the user taxonomy categories relevant to the search term and the user may then select from only those presented taxonomy categories to further refine their search. By “pushing data back to the user,” the system of Talib never presents invalid, zero-member categories and, therefore, prevents a user from specifying a product that does not exist within the electronic catalog taxonomy. (See Figs. 10 and 11, Paras. 120 – 146).

When Talib is considered in its entirety, it is evident that, by preventing a user from “defining a product that does not exist” within the electronic catalog, the system of

Talib, *by its express design*, will always return to a customer information for a product that already exists within the electronic catalog when a search is performed. Since product information for products that already exist within the electronic catalog is always returned when a search is performed using the system of Talib, an instance never arises in Talib where the electronic database fails to *contain information for the product being requested*. Accordingly, the system of Talib can never determine that “the electronic database does not contain information for a product,” and, as such, the system of Talib never “performs a search outside of the electronic database to gather information for the product [requested that was not in the database] which gathered information is returned to the customer in an electronic message and added to the electronic database.”

From the foregoing, it is submitted that Talib fails to disclose “the invention substantially as claimed” when the claims are considered *as a whole*, i.e., Talib fails to disclose any instance where information for a product would not be found in the electronic catalog, any instance where a search would be performed outside of the electronic catalog to gather information for a product not found in the electronic catalog, or any instance where information gathered outside of the electronic catalog is then added to the electronic catalog. Therefore, since Talib fails to disclose those elements being relied upon in the obviousness rejection set forth in the Office Action, the rejection of the claims under 35 U.S.C. § 103 must be withdrawn.

It is further respectfully submitted that, while the Office Action is correct in noting that “Talib does not specifically disclose an automatic request to a sourcing agent to perform a search outside the database to gather information unavailable in the database,” the Office Action fails to consider that Talib, *by its express design*, desires this

very omission. As discussed extensively above, Talib has expressly designed a system which seeks to limit searches to taxonomies that are defined for products that are already within an electronic catalog. The principle of the design of the Talib system requires the transmission and display of taxonomy categories for users to select from rather than providing users with long laundry lists of electronic record hits as is returned using a search engine. (Para. 0036).

Turning now to Liddy, Liddy discloses the exact type of search engine that Talib seeks to avoid. Specifically, Liddy discloses a system for retrieving documents from the Internet. To this end, a user enters a search query and based upon a user profile an agent server generates meta-search agents which are sent to general purpose search engines and specialized search engines on the Internet to retrieve documents and/or crawler agents that are sent directly to Web sites to retrieve documents. (Col. 6, lines 26-31; Col. 9, line 66-Col. 10, line ). Thus, Liddy describes nothing more than the exact type of searching technology that the system of Talib expressly seeks to avoid using, namely, a search engine that is equivalent to those described in the Background Section of Talib.

From the foregoing, it will be appreciated that a modification of Talib to incorporate the additional database searching technology of Liddy would impermissibly change the principle of operation of Talib, i.e., it would not only allow for searching beyond the stringent taxonomy provided to the Talib catalog but would also incorporate into Talib the very type of search engine that Talib expressly seeks to avoid. Therefore, since the modification of Talib that has been espoused in the Office Action would change the principle of operation of Talib, a prima facie case of obviousness has not been established and the rejection of the claims must be withdrawn.

CONCLUSION

The subject application is considered to be in condition for allowance. Such action on the part of the Examiner is respectfully requested. Should it be determined, however, that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

While it is not believed that any fee is due, the Commissioner is hereby authorized to charge any fee deficiency to deposit account number 50-2428 in the name of Greenberg Traurig.

Respectfully Submitted

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